

### **REMARKS**

Claims 1-13, 32-37 and 39-49 are pending in this application. Claim 4 has been withdrawn from consideration. In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

In particular, the independent claims have been rewritten to clarify the invention. Accordingly, claim 38 has been canceled to maintain consistency with the amended independent claims. In addition, various dependent claims have been rewritten to correct § 112 issues. As no new matter has been added by the amendments herein, Applicants respectfully request entry of these amendments at this time.

### **REJECTIONS UNDER 35 U.S.C. § 112**

Claim 34 was rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement for the reasons provided on page 2. In addition, claims 34-40 were rejected under § 112, second paragraph, as being indefinite for the reasons set forth on page 3.

Claim 34 has been rewritten to include “hydroxy-terminated” in front of each acrylate. Applicants respectfully submit that the use of the term “hydroxy-terminated” in front of the first acrylate in the list recited in claim 34 was intended to refer to each acrylate in the list. In an effort to clarify the invention, however, the claim has been rewritten to elucidate this intention.

Claims 34-40, 42-43, 45, and 47-49 have also been rewritten to clarify the subject matter of the recited invention.

In light of these amendments, Applicants respectfully submit that the § 112 rejections have been overcome. As such, Applicants respectfully request reconsideration and withdrawal of the § 112 rejections.

### **REJECTIONS UNDER 35 U.S.C. §§ 102 & 103**

Claims 1-3, 5-6, 8-13, 32-36, and 38-40 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, as being obvious over, Japanese Patent Publication No. 07048477 (“the ‘477 publication”) for the reasons stated on pages 3-4 of the Office Action. In addition, claims 1-3, 5-13, and 32-40 were rejected under § 103(a) as being

obvious over the '477 publication in view of U.S. Patent No. 6,180,040 to Ladd *et al.* as set forth on page 4 of the Office Action. The Examiner also rejected claims 1-3, 5-6, and 8-13 under § 103(a) as being obvious over the '477 application in view of U.S. Patent No. 6,439,873 to Marshall. None of the cited references, or any combination thereof, disclose or suggest the present invention for at least the reasons that follow.

The '477 publication is directed to golf ball compositions made of rubber, a metal acrylate, urethane acrylate, and an organic peroxide. *See* Abstract. As recognized by the Examiner, these rubber-based compositions are present in the core. In contrast, all of the independent claims now clarify that the acrylate functional composition is present in the cover.

In addition, with respect to independent claims 32 and 41, the '477 publication teaches a convention rubber-based composition including various acrylates. As known to those of ordinary skill in the art, acrylates are commonly used in rubber-based golf ball core compositions, *e.g.*, zinc acrylate. In contrast, the composition of the invention is based on a polyurethane backbone with acrylate functionality. The backbone provides the resilient portion of the polymer, while the acrylic end segment provides crosslinkability and maximizes the urethane properties. *See e.g.*, Page 6, line 25 to Page 7, line 6. The '477 publication is completely silent with respect to acrylate functionality in urethane-based compositions.

Furthermore, with respect to independent claim 41, the '477 publication teaches a two-piece golf ball with the core including the acrylate containing rubber-based composition. In contrast, the present invention features a golf ball with at least three layers, where at least one of the inner and outer cover layers include the composition of the invention.

Finally, in view of the limited manner in which the Examiner uses the secondary references, Applicants respectfully submits that these references do not cure the deficiencies of the '477 publication. In particular, like the '477 publication, both Ladd and Marshall are directed to rubber-based core compositions. As such, neither reference would have motivated a skilled artisan to make a golf ball cover with a urethane-based acrylate functional composition.

For at least these reasons, Applicants respectfully submit that the cited references do not teach or suggest the present invention. Thus, Applicants respectfully request reconsideration and withdrawal of the § 102 and § 103 rejections based thereon.

### LINED OUT REFERENCES

Applicants respectfully submit copies of the references lined out by the Examiner on the previously submitted 1449 form, with the exception of Ref No. CJ. Applicants will submit this reference as soon as possible. A clean copy of the 1449 form is also submitted herewith in order to facilitate the Examiner's indication of consideration for the submitted references on the form, as well as the previously considered references.

### CONCLUSION

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response one month to and including November 19, 2005. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Swidler Berlin LLP Deposit Account No. 195127, Order No. 20002.0333.

Respectfully submitted,  
SWIDLER BERLIN LLP

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